

## **REMARKS**

### **Status of the Claims**

Upon entry of the amendment above, claims 1-6, 8-12, and 14-23 will be pending, claims 1, 6, 12, and 20 being independent.

### **Summary of the Office Action**

On page 2 of the Office action, it is explained that "[t]he proposed drawing correction and/or the proposed substitute sheets of drawings, filed on October 21, 2002, have been approved." However, seemingly inconsistent with the approval, in the immediately following sentence, a requirement is made that a proper correction or corrected drawings are required to avoid abandonment.

The specification is objected to under 35 USC §132 for having had "new matter" added to paragraphs [0041] and [0061] of the specification.

Claims 7-20 are rejected under 35 USC §112, first paragraph, as allegedly containing subject matter of which Applicants were not in possession at the time the application was filed, *i.e.*, for non-compliance with the written description requirement of §112, first paragraph.

Claims 1-20 are rejected under 35 USC §103(a) as being unpatentable over KELLER et al. (U.S. Patent No. 5,909,893, hereinafter "KELLER") in view of TANAKA (U.S. Patent No. 6,386,574).

### **Response to the Office Action**

#### **A. Corrected Drawing**

With Applicants' reply to the first Office action, they filed a proposed amendment as well as a corrected formal drawing conforming to the amendment. Inasmuch as the amendment has been approved, Applicants request that the objection to the drawing be withdrawn.

Further, because a corrected drawing was filed with Applicants' previous reply, Applicants have already complied with the requirement for filing corrected drawings.

However, Applicants are filing a duplicate of the corrected drawing for the convenience of the Office. As can be seen, in the corrected drawing (of Fig. 1), reference characters IV-IV have replaced reference characters III-III, to indicate properly that Fig. 4 is a cross-sectional view taken at the indicated line in Fig. 1.

**B. Withdrawal of Objection to Specification**

In response to the objection under 35 USC §132, Applicants have deleted the amendments that they had made to paragraphs [0041] and [0061] of their specification. Accordingly, withdrawal of the objection is requested.

Nevertheless, Applicants submit that the objection was improper and, to correct any misunderstanding of the invention which might have been evidenced by the objection, Applicants provide the following explanation.

From the comments at the top of page 3 of the Office action, it appears that a consideration of the invention has been made only *with regard to the configuration of the assembly of the invention as the assembly is mounted upon the board 2* and *not* with regard to the configuration in which the invention can exist as an assembly independent of the board. It is the latter configuration for which the amendment had been directed.

That is, the objection includes the statement that "[a]ccording to the original disclosure, the screw is mounted on the plate by placing the smooth portion into the hole, and allowing the threads to extend beyond the plate to engage the board." That statement, of course, is correct. However, that statement is *not* inconsistent with the fact that, before the assembly 1 is mounted upon the board 2, the screws 30, 31, 32, 33 are effective in retaining the screws in a particular orientation with respect to the base 3, such as with respect to the disk 20 of the base 3, by means of the plate 50, either by having the screws in threaded engagement with the holes of the plate or by having the threaded portions of the screws positioned beyond the holes of the plate.

The Examiner is correct regarding the disclosures of paragraphs [0042] and [0062]. That is, *after the screw is screwed through the plate 50*, the threaded portion 57 of the screw is on the other side of the plate with respect to the head 55 of the screw. For example, in the configuration in which the base 3, or the disk 20 of the base, is secured to the snowboard 2, the screws 30, 31, 32, 33 are no longer in threaded engagement with the plate 50. Indeed, as explained in paragraph [0045], as seen in FIG. 4, in the area of the elongated holes 34, 35, the screws 30, 31 extend through both the elongated holes of the disk 20 and the holes 51, 52 of the plate 50, respectively, so as to be screwed into the bushes 38, 39 of the board 2.

However, consistent with the original disclosure, *before* the screws are screwed into the board 2, the plate 50 enables the orientation of all of the screws to be maintained (even with the threaded parts 57 of the screws on the opposite side of the plate relative to the heads 55 of the screws, as mentioned in paragraph [0042]) so that, when the user positions one of the screws along an elongated hole, in order to position the screw on a bushing 38, 39, 40, 41 of the board, all of the screws are displaced simultaneously to their proper positions on a respective one of the bushings (see paragraph [0046]). The prior art relied upon in the §103 rejection fails to teach or suggest this feature of the invention.

According to the invention, the user positions all of the screws in a single manipulation. As a result, the mounting and adjusting operations are less time-consuming and simpler and the positioning of the retention assembly on the board is easier.

**C. Withdrawal of Rejection Under 35 USC §112, First Paragraph**

In response to the rejection under 35 USC §112, first paragraph, Applicants have amended independent claims 7 and 13 to delete reference to the screws being in "threaded engagement" with the plate. Accordingly, reconsideration and withdrawal of the rejection is requested.

However, for the reasons mentioned above (in Section B) in response to the objection to the specification, claims 7 and 13, as originally presented in Applicant's first reply, are consistent with the original disclosure. That is, the screws are threadably engageable with the plate, albeit not when the assembly of the invention is fitted upon a board, whereby the screws are screwed into the board.

The invention, of course, is not limited in scope to a configuration by which the assembly is always mounted upon the board.

**D. Withdrawal of Rejection Under 35 USC §103(a)**

Applicant requests that the rejection of claims 1-20 under 35 USC §103(a) based upon a combination of KELLER and TANAKA be withdrawn.

In claim 1, Applicants call for, *inter alia*, "each screw extending through a hole of *the* plate ...." That is, each screw in Applicants' assembly, extends through a hole of a *single* plate.

By contrast, in KELLER, a first pair of screws 8 extend through a pair of holes in a first plate 12 and a second pair of screws 8 extend through a pair of holes in a second plate. *Each of the screws 8 of KELLER's disclosed retaining apparatus do not extend through one plate.* Further, TANAKA provides no teaching or suggestion to supply this deficiency of KELLER.

In addition, claim 1 includes the limitation "retaining means for retaining the screws on the plate." This limitation, to be construed according to 35 USC 112, sixth paragraph, cannot be properly construed to be met by KELLER or a combination of KELLER and TANAKA. The invention is directed to "An assembly for retaining a boot on a sports apparatus" and not to "a sports apparatus in combination with an assembly for retaining a boot." That is, it would appear that the board itself in KELLER, or in the combination of KELLER and TANAKA, not a part of the assembly, would be necessary to retain the screws on the plates.

In the amendment above, claim 6 has been rewritten in independent form. Claim 6 further emphasizes the point made above, *i.e.*, "all of the at least two screws extending through respective ones of the holes of the plate."

As mentioned above, independent claims 7 and 13 have been canceled. In their place, formerly dependent claims 12 and 20 have been rewritten in independent form. Claims 12 and 20, like claim 6, include the limitation "all of the at least two screws extending through respective ones of the holes of the plate."

Further, original claim 5 specifies that "the plate has four holes spread to the four corners of a square." Claims 11 and 19 include a similar limitation. There is no plate in either KELLER or TANAKA that has four holes as specified in claims 5, 11, and 19.

New claim 21, depends from original claim 1 and further specifies that the plate of the retaining assembly "is a single plate." No new issue is raised with claim 21 inasmuch as the original claim 1 had called for "at least two holes extending through the plate" and that "each screw [extends] through a hole in the plate. Therefore, original claim 1 can be construed as requiring the assembly of the invention includes one and only one plate having screws extending through it.

New claims 22 and 23 retain the relationship, from former claims 7 and 13, respectively, that the screws are "threadably engageable" with respective holes of the plate and, therefore, do not raise a new *issue* (nor an issue of new matter, for reasons explained above).

### SUMMARY AND CONCLUSION

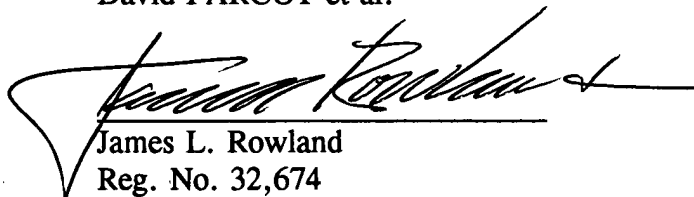
The grounds of objection and rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is enclosed for payment of a claim fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
David FARCOT et al.



James L. Rowland  
Reg. No. 32,674

March 17, 2003  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191

(703) 716-1191 (telephone)  
(703) 716-1180 (fax)